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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.       |
|---|-------------|----------------------|---------------------|------------------------|
| 09/533,493  | 03/23/2000  | Oscar Jimenez        | 20037               | 1061                   |
| 24628   | 7590        | 07/26/2004           | EXAMINER            |                        |
| WELSH & KATZ, LTD<br>120 S RIVERSIDE PLAZA<br>22ND FLOOR<br>CHICAGO, IL 60606 |             |                      |                     | NGUYEN, ANH TUAN TUONG |
|   |             | ART UNIT             |                     | PAPER NUMBER           |
|   |             | 3763                 |                     |                        |

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/533,493             | JIMENEZ, OSCAR      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Anhtuan T. Nguyen      | 3763                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 11-16 is/are allowed.

6) Claim(s) 17-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 7-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Jimenez (5,445,624).

Jimenez discloses a catheter assembly (Figures 4-8) comprising a tubular body (112) and a separate distal tip (110) wherein the tip may be made from thermoplastic material including polyurethane (5:26-28) and that the outer coating may be made with radiopaque material (6:52-54 with various Shore hardness.

3. Claims 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Trotta (6,325,790) or by Helgerson (6,149,996).

4. Trotta discloses an invention as claimed, i.e., a catheter assembly (Figures 1-6) comprising a tubular body (12) having a soft tip member (44) connected between a separate distal tip member (46) and the body (2:6-9). The tip member includes radiopaque material such as bismuth subcarbonate (2:44-48) and polyurethane (2:53-55, 4:43-44, 5:11-14).

5. Helgerson discloses an invention as claimed, i.e., a catheter assembly (Figure 1) comprising a tubular body (12) having a separate distal tip member (30). The tip member

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includes radiopaque material such as bismuth subcarbonate (2:44-48) and a thermoplastic material including polyurethane (2:19-25, 2:35-40) wherein the tip may have different Shore hardness.

***Response to Arguments***

6. Applicant's arguments with respect to claims 11-22 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

7. Claims 11-16 are allowable over the prior art searched and those of record.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anhtuan T. Nguyen whose telephone number is 703-308-2154. The examiner can normally be reached on Mon-Fri, 0830-1800 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anhtuan T. Nguyen  
Primary Examiner  
Art Unit 3763